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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/492,373	01/27/2000	Yuzo Horikoshi	991444	9795

23850 7590 07/17/2003

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EXAMINER

SHOSHO, CALLIE E

ART UNIT PAPER NUMBER

1714

DATE MAILED: 07/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/492,373

Applicant(s)

HORIKOSHI ET AL.

Examiner

Callie E. Shosho

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): 35 USC 112, 1st paragraph rejection of record.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-2, 4, 6-10, and 14-18.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Callie E. Shosho
Primary Examiner
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Attachment to Advisory Action

1. Applicants' amendment filed 7/1/03 has been fully considered. Applicants' arguments overcome the 35 USC 112, 1st paragraph rejection of record.

However, the rejection of record as set forth in paragraph 5 of the office action mailed 4/9/03, Paper No. 16, namely, Nguyen et al. (U.S. 6,248,805) in view of Patel et al. (U.S. 5,977,210) and Fujisawa et al. (U.S. 5,977,136), remains.

Applicants have amended all the claims to recite that the polymer is obtained from 40-80 wt.% styrene. In light of the amendment, applicants argue that Nguyen et al. is no longer a relevant reference against the present claims given that the polymer of Nguyen et al. is obtained from less than 30 wt.% styrene.

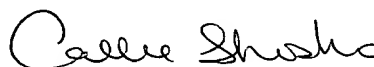
It is agreed that col.5, lines 6-7 of Nguyen et al. disclose polymer obtained from less than 30 wt.% styrene. However, this is but one preferred embodiment of Nguyen et al. It is noted, "nonpreferred disclosures can be used. A nonpreferred portion of a reference disclosure is just as significant as the preferred portion in assessing the patentability of claims." *In re Nehrenberg*, 280 F.2d 161, 126 USPQ 383 (CCPA 1960). A fair reading of the reference as a whole discloses that styrene is broadly used in amounts of 5-95%, which clearly overlaps the amount of styrene presently claimed (col.4, lines 45-48 and 56-57). Further, this portion of Nguyen et al. also discloses other preferred amounts of styrene including 10-60 wt.% and 15-50 wt.%, which each overlap the amount of styrene presently claimed.

Applicants also argue that the amounts and types of monomers from which the copolymer is obtained are necessary to achieve rapid drying and fixation. While there is no explicit disclosure in Nguyen et al. regarding the fixation or drying time of the ink, given that

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Nguyen et al. disclose copolymer obtained from the same types and amounts of monomer as presently claimed, including the amount of styrene, it would have been natural for one of ordinary skill in the art to infer that the ink would intrinsically possess rapid drying and good fixation.

In light of the overlap between the amount of styrene presently claimed and that disclosed by Nguyen et al., it therefore would have been obvious to one of ordinary skill in the art, absent evidence to the contrary, to use styrene in amounts, including those presently claimed, and thereby arrive at the claimed invention.



Callie E. Shosho
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Art Unit 1714

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July 17, 2003